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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,280	05/16/2001	Ralph C. Gray	1656A1	2673

7590 07/22/2003

PPG INDUSTRIES, INC.  
Intellectual Property Department  
One PPG Place  
Pittsburgh, PA 15272

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/858,280

Applicant(s)

GRAY ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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Claims 16-28 are drawn to inventions nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancellation of the nonelected claims or other appropriate action (37 CFR 1.144 and MPEP § 821.01).

Claim 15 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the composition with corrosion resistant pigments, there being no allowable generic or linking claim. Applicant timely traversed the restriction and election of species requirement in Paper No. 4.

The newly claimed proportion of from 50 to 90 percent by weight of the reaction product of an epoxy-containing polymer and phosphorus acid groups-containing compound overcomes the 35 U.S.C. 103(a) rejection over Soltwedel which discloses a maximum of about 0.5 percent by weight of the epoxy resin-phosphoric acid reaction product (col. 11, line 65).

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. and Young et al. in view of Japanese Patent No. 7-331164.

The rejection is maintained for the reasons of record set forth in the previous Office action. The arguments filed July 11, 2003 have been considered but are unpersuasive.

Berger et al. does not recite the newly claimed level of from 50-90 percent by weight of the reaction product of an epoxy-containing polymer and phosphorus acid groups-containing compound. Young, Jr. et al. shows a weldable coating containing from 60-90 weight percent of an epoxy resin and from 10-40 weight percent of a curing agent. It would have been obvious to employ the epoxy-containing material of Berger et al. within the exemplified amount of from 60-90 weight percent of Young, Jr. et al. in order to enhance the adhesion of the coating imparted by the epoxy-containing material.

Berger et al. and Young, Jr. et al. does not recite the claimed reaction product of the epoxy resin with a phosphorus acid groups-containing compound. The motivation and reasonable expectation of success for reacting the epoxy resin of Berger et al. and Young, Jr. et al. with phosphoric acid rests with the Japanese patent which ascribes "good storage stability and coatability, and forms coating films with good adhesion, water resistance, and fabrication properties (abstract, Advantage section)" to component (P1) which includes the phosphoric acid-modified epoxy resin.

It is unclear how it is concluded that the Japanese patent teaches from 0.1-20 percent by weight of phosphoric acid-modified epoxy resin since the abstract does not mention any proportions. However, a secondary reference need not recite each and every limitation of the claims. The primary reference to Young, Jr. et al. establishes the use of an epoxy resin at a content of from 60-90 weight percent which is within the claimed parameters.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(703) 308-2399 (Fax no. (703) 872-9311)  
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers  
Primary Examiner  
Art Unit 1712